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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/562,833

09/06/2006

Toshiya Fujisato

AKA-0292

8388

23599 7590 11/18/2011  
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EXAMINER

FIEBIG, RUSSELL G

ART UNIT

PAPER NUMBER

1655

NOTIFICATION DATE

DELIVERY MODE

11/18/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/562,833	FUJISATO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	RUSS FIEBIG	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) ☒ Claim(s) 1-25 is/are pending in the application.
- 5a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 20-25 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1205</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

Applicant's election with traverse of Group IV, claims 20-25, in the reply filed on September 26, 2011 is acknowledged. The traversal is on the grounds that the special technical feature makes a contribution over the prior art. However, conclusory statements are not evidence of a special technical feature, which Applicant fails to identify and does not indicate what this contribution over the prior art actual entails.

The requirement is still deemed proper and is therefore made **FINAL**.

Claims 20-25 are presented for examination on the merits (claims 1-19 are withdrawn from consideration as being drawn to a non-elected invention).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata et al. (JP 2001046500) in view of Saishin et al. (US 2001/0049532).

A system for injecting cells into a biological tissue segment comprising the recited means for performing the recited steps is claimed.

Shibata et al. beneficially discloses a medical injection apparatus comprising (a) an ultrasonic vibrator (i.e., means for generating microvibration), (b) a cover for covering the vibrator, (c) a probe for connecting to the vibrator and transmitting the vibrations, (d) a needle at the tip of the probe and (e) wherein the probe is formed with a through-hole opened by the needle part, and a base to which a syringe with an injection fluid sealed therein, is provided in the cover so as to connect to the through-hole (see entire document, including e.g., claim 1).

Saishin et al. beneficially disclose an invention wherein a hole is bored using trepan bar 10 with suction between outer cylinders 22 and 23 (see entire document, including figures 4(A-C)).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to further include a means for applying a negative and positive pressure (i.e., suction) within the apparatus taught by Shibata et al. based upon the beneficial teachings provided by Saishin et al. for the following reasons. It would be obvious to a skilled artisan to provide a means for suctioning tissue during hole boring in the device for medical injection of Shibata et al. for its recognized benefits. The adjustment of particular conventional working conditions (e.g. injecting a predetermined volume in a predetermined distance depending upon the

Art Unit: 1655

specific application) is deemed merely a matter of judicious selection, design choice, and routine optimization which is well within the purview of the skilled artisan. The instant application appears to recognize the problems existent in the prior art devices, but recognition of a problem is not sufficient for patentability. The instantly claimed invention appears to be merely a combination known elements (i.e., microvibration of injection needles with positioning devices (see paragraph [0015]). (See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007) "Such a combination according to known methods is likely to be obvious when it does no more than yield predictable results.")

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

### ***Conclusion***

No claims are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RUSS FIEBIG whose telephone number is (571)270-5366. The examiner can normally be reached on M-Th 8-5, F 8-4 EST.

Art Unit: 1655

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571)272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rgf

/Christopher R Tate/  
Primary Examiner, Art Unit 1655